



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,334	05/11/2001	Dan Kikinis	004688.P016	7799

52940 7590 09/22/2006

TODD S. PARKHURST  
HOLLAND & KNIGHT LLP  
131 S. DEARBORN STREET  
30TH FLOOR  
CHICAGO, IL 60603

EXAMINER

MA, JOHNNY

ART UNIT	PAPER NUMBER
----------	--------------

2623

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/854,334

Applicant(s)

KIKINIS ET AL.

Examiner

Johnny Ma

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

It is noted that applicant does not traverse the examiner's assertion of official notice, in the previous Office Action. Therefore, the well known in the art statement that it is well known in this art that an EPG is capable of replenishing programming information is taken to be admitted prior art.

#### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, 8, 12-17, 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton, III et al.* (US Pat. No. 5,745,710 of record) in further view of *Boylan, III et al.* (US Pat. No. 6,799,326 B2).

Applicant's claim 1 recites a system comprising:

- a. a unit to generate an interactive 3-D EPG selecting at least one of a plurality of objects stored at a user's location; and
- b. a communication module coupled to a network in order to receive localized content, the localized content targeted to a particular locality.

As to claim 1, *Clanton* discloses a system capable of generating a 3-D EPG (Fig. 7 & Col. 2, Ln. 43-67 thru Col. 3, Ln. 1-5). *Clanton* also teaches the ability to “select” at least one of a plurality of objects stored at a user’s location wherein the user/system is allowed to select various objects within the 3-D space, which are then used to display other aspects of the EPG. (Col. 7, Ln. 7-18; Col. 8, Ln. 37-44; Col. 9, Ln. 15-21). These objects and the other related data used to create the EPG, are stored at the user location. Thus, it is inherent the system select these objects when generating the EPG display. Accordingly, the unit would generate the EPG based upon a selection of various objects stored at the user’s location. *Clanton* further teaches displaying advertisements from local merchants (Col. 12, Ln. 14-17) wherein it is inherent this localized content be provided via some form of communication module. However, *Clanton* does not specifically teach the localized content targeted to a particular locality. Now note the *Boylan* reference that teaches an interactive television program guide system with local advertisements. The claimed “the localized content targeted to a particular locality” is met by “television distribution television facility 52, filter 82 extracts the local advertisements from the data stream that are addressed to either the local area in which television distribution facility 52 and its associated user television equipment 54 are located or to a group of users associated with television distribution facility 52. Users are therefore provided with local advertisements whose content is tailored to the user’s geographic location” (*Boylan* 8:59-9:4). Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the *Clanton* local merchant advertisements with the *Boylan* localized content targeted to a particular locality for the purpose providing a means for tailoring

advertisements to specific users thus increasing the effectiveness of the advertising and presenting advertisements that are relevant to a user's location.

Claims 12 and 23 are method and apparatus claims, respectively, which correspond to claim 1. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 2, *Clanton* further discloses the system comprises a set-top box and a television. (Fig. 1). Accordingly, *Clanton et al* anticipate each and every limitation of claim 2.

Claims 14 and 24 are method and apparatus claims, respectively, which correspond to claim 2. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 4, *Clanton* further discloses the system contains 3-D objects stored in memory (Col. 7, Ln. 15-18), which correspond to the programming events (Col. 8, Ln. 19-36 & Fig. 4-13). Selecting one of these 3-D objects will cause the system to display additional virtual worlds corresponding to the selected object. (Col. 9, Ln. 13-21). Accordingly, *Clanton et al* anticipate each and every limitation of claim 4.

Method claims 13 and 15 and apparatus claim 26 correspond to system claim 4. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 5, *Clanton* further discloses a 3-D EPG containing the title (Fig. 5) and channel identification (Fig. 10) of a program. (Note: The USPTO considers applicant's "at least one of" language to be anticipated by any reference containing one of the subsequent corresponding elements.) Moreover, *Clanton* incorporates by reference U.S. Patent #4,706,121 to Young, which discloses an EPG containing category, title, date, and the start time of television programs. (*Clanton* Col. 2, Ln. 4-11). Accordingly, *Clanton et al* anticipate each and every limitation of claim 5.

Claims 16 and 27 are method and apparatus claims, respectively, which correspond to the system claim 5. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 6, *Clanton* further discloses the system can display advertisements from local merchants. (Col. 12, Ln. 1-17). Accordingly, *Clanton et al* anticipate each and every limitation of claim 6.

Claim 17 corresponds to the system claim 6. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, *Clanton* further discloses the system displays the interior of 3-D objects, such as the “Critic’s Café” of Figure 6, after they have been selected. (Col. 9, Ln. 15-21). Accordingly, *Clanton et al* anticipate each and every limitation of claim 8.

4. Claims 3, 9, 18-22, 25, 28-30, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton* (of record) in view of *Boylan, III et al.* (US Pat. No. 6,799,326 B2) and *LaJoie et al.* (US Pat. No. 5,850,218 of record).

Applicant’s claim 3 recites the system of claim 1, wherein the system includes a plurality of drivers, one of the drivers communicating with a separate unit to replenish programming information. Applicant has defined driver as a “connector”, and the examiner interprets it accordingly. (Spec. Page. 8, Par. [0026]). As discussed above, *Clanton* anticipates each and every limitation of applicant’s claim 1, but fails to teach the limitations of claim 3. However, within the same field of endeavor *LaJoie* discloses a similar system which is connected to a plurality of units, which enables it to provide an EPG, web browsing, email, online services, Near Video on Demand, Pay-Per-View, and Video on Demand services. (Col. 2, Ln. 1-11). Moreover, the examiner takes Official Notice that it is well known in this art that an EPG is

Art Unit: 2623

capable of replenishing programming information. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combined teachings of *Clanton* and *LaJoie* to further include a well-known method of replenishing the EPG system in order to supply the user with current and up-to-date programming information.

Claim 25 is an apparatus claims which corresponds to system claim 3. It is analyzed and rejected as previously discussed.

Applicant's claim 9 recites the system of claim 8, wherein a subset of the virtual world is displayed as a matrix of rectangular boxes containing current programming information. As discussed above, *Clanton* contains all limitations of claim 8, and *LoJoie* further discloses the EPG contains a matrix of rectangular boxes containing current programming. (Fig. 16). Thus, *Clanton* and *LaJoie* contain all limitations of applicant's claim 9.

Claims 20 and 30 are method and apparatus claims, respectively, which correspond to the system claim 9. Each is analyzed and rejected as previously discussed.

Applicant's claim 18 recites the method of claim 17, wherein the memory in the system includes a third set of non-EPG objects including objects for e-commerce. Applicant did not provide a clear definition of "non-EPG" objects, therefore the examiner interprets the term to be objects that do not correspond to programming events. As discussed above, *Clanton* contains all limitations of claim 17 and *Clanton* further teaches the use of "extras", which advertise for various non-EPG services (pizza delivery, etc.). (Col. 12, Ln. 14-22). Combined with *LaJoie*'s online capabilities discussed above, these "extras" can be used in e-commerce. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention

Art Unit: 2623

to further modify the combination of *Clanton* and *LaJoie* to also include the non-EPG “extras” teaching of *Clanton* in order to provide a method by which a user can partake in e-commerce.

Claim 28 corresponds to Claim 18. Thus, it is analyzed and rejected as previously discussed.

Claim 19 mirrors the language of claim 8. Thus, it is analyzed and rejected as discussed therein.

Applicant’s claim 21 recites the method of claim 20, further including uploading content of the third set of non-EPG objects in real time. As discussed above, *LaJoie* discloses an EPG with Internet capabilities and *Clanton* discloses an EPG capable of displaying localized content. Those of ordinary skill in this art recognize it would have been obvious in systems having Internet capability, that they receive streaming data via a server which retrieves the data in real-time. Therefore, further modifications of the combined teachings of *Clanton* and *LaJoie* would result in a system which is capable of uploading localized content in real-time. Accordingly, each limitation of applicant’s claim 21 is contained within the combined teachings of *Clanton* and *LaJoie*.

Claim 33 corresponds to claim 21. Thus, it is analyzed and rejected as previously discussed.

Applicant’s claim 22 recites the method of claim 21, which further includes an interface for a user to interact with the localized content of the 3-D EPG. As discussed above, *Clanton* and *LaJoie* contain all limitations of applicant’s claim 21, and *Clanton* further discloses a user interface in which the user can select “extras” corresponding to local services available to the



user. (Col. 11, Ln. 54-67 through Col. 12, Ln. 1-17). Thus, *Clanton* and *LaJoie* contain all limitations of claim 22.

Claim 34 corresponds to claim 22. Each is analyzed and rejected as previously discussed.

Claim 29 mirrors the language of claim 8. Thus, it is analyzed and rejected as discussed therein.

Applicant's claim 32 mirrors the language of claim 6. Thus, it is analyzed and rejected as discussed therein.

5. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton III, et al* (of record) in view of *Boylan, III et al.* (US Pat. No. 6,799,326 B2) and *Hassell et al.* (US Pat Pub. No. 2004/0107439 of record).

Applicant's claim 7 recites the system of claim 4, wherein the memory in the system includes a third set of non-EPG objects including objects for e-commerce which correspond to programming events. As discussed above, *Clanton* contains all limitations of claim 4 and *Clanton* further teaches the use of "extras", which advertise for various services (pizza delivery, etc.). (Col. 12, Ln. 14-22). But, *Clanton* fails to teach these "extras" being used for e-commerce items related to programming events. However, within the same field of endeavor, *Hassell* discloses a similar system which provides an EPG capable of providing e-commerce items that correspond to programming events. (Abstract; Fig. 32; Pars. [0003, 0144]). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine *Clanton* and *Hassell*, thereby providing a system which gives the user immediate access to data related to programming.

Applicant's claim 10 recites the system of claim 7, wherein the localized interactive content of the third set of objects is uploaded in real time. As discussed above, *Hassell* discloses an EPG with e-commerce (i.e., internet) capabilities and *Clanton* discloses an EPG capable of displaying localized content. Those of ordinary skill in this art recognize it would have been obvious in systems having Internet capability, that they receive streaming data via a server which retrieves the data in real-time. Therefore, further modifications of the combined teachings of *Clanton* and *Hassell* would result in a system which is capable of uploading localized content in real-time. Accordingly, each limitation of applicant's claim 10 is contained within the combined teachings of *Clanton* and *Hassell*.

Applicant's claim 11 recites the system of claim 10, which further includes an interface for a user to interact with the localized content of the 3-D EPG. As discussed above, *Clanton* and *Hassell* contain all limitations of applicant's claim 10, and *Clanton* further discloses a user interface in which the user can select "extras" corresponding to local services available to the user. (Col. 11, Ln. 54-67 through Col. 12, Ln. 1-17). Thus, *Clanton* and *Hassell* contain all limitations of claim 11.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton* (of record) in view of *Boylan, III et al.* (US Pat. No. 6,799,326 B2) and *LaJoie* (of record) as applied to claim 30 above, and further in view of *Kamen et al.* (US #6,421,067 of record).

Applicant's claim 31 recites the storage medium of claim 30, wherein a user of the system chooses a virtual world to display programming information. As discussed above, *Clanton* and *LaJoie* contain all limitations of claim 30 but fail to disclose a method by which the user is allowed to choose the virtual world that displays the program information. However, in

Art Unit: 2623

the same field of endeavor, *Kamen* discloses a 3-D EPG system in which the user, via a remote control, can modify the EPG surfaces. *Kamen* allows the user to choose lighting, color, texture, or positions of objects within the 3-D space. (Col. 3, Ln. 35-65). Even though the user is not allowed to choose a completely new virtual world, he is still allowed to choose certain characteristics of the virtual world, which give it a new look and feel. Choosing a different virtual world is only an obvious variant to manipulating the existing virtual world to give it a different look and feel, as in *Kamen*. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the teachings of *Clanton* and *LaJoie* with the virtual world manipulating capabilities of *Kamen* in order to provide the user with a method of selecting and personalizing a virtual world of their choosing.

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 2623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (571) 272-7351. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jm

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600